

### **REMARKS/ARGUMENTS**

These remarks are responsive to the non-final Office Action mailed June 21, 2010 (“Office Action”). Applicant respectfully requests reconsideration of the current rejections of the pending claims in light of the foregoing amendments and the following remarks.<sup>1</sup>

#### **Status of the Claims**

Claims 21-26 and 52-71 are currently pending in the present application, with claims 21, 24, 58, 62, 66, and 69 being the independent claims. Claims 22, 25, 59, 63, 67, and 70 have been cancelled. Claims 21, 24, 58, 62, 66, and 69 have been amended to more clearly recite the claimed subject matter. No new claims have been added.

#### **The Rejection Under 35 U.S.C. § 103(a)**

The Office Action rejects claims 21-26 and 52-71 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Number 6,089,284 to Kaehler, *et al.* (“Kaehler”) in view of U.S. Patent Number 6,301,741 to Dahm *et al.* (“Dahm”). *See* Office Action, page 1. Applicant respectfully traverses this rejection.

Claim 21 recites, in part, “electronically associating said transmitter identification data with said payment information.” The Office Action asserts that this limitation is disclosed by Kaehler. *See* Office Action, page 1. Applicant respectfully disagrees. As currently amended, claim 21 indicates that the payment information “corresponds to a credit card, debit card, or bank account, or a combination thereof.” Applicant respectfully submits that neither Kaehler nor Dahm discloses or suggest electronically associating transmitter identification data with payment information, wherein the payment information corresponds to a credit card, debit card, or bank account, or a combination thereof.

The Office Action relies upon Kaehler, at col. 18, lines 11-23, discloses “wherein said payment information corresponds to a credit card, debit card, or bank account, or a combination thereof.” *See* Office Action, page 2. Applicant respectfully disagrees. The cited portion of Kaehler discloses:

Initially, the control system will determine whether or not a transponder is being used in association with the transaction (block 640). If a transponder is being used, the control system will provide a first discount rate to all or a portion of the transaction (block 640), and proceed to determine transaction totals (block 650). If a transponder is not used in association with the transaction, the control system may determine whether or not a card, such as debit, credit or smartcard, is used with the transaction (block 642). If a card is used in association with the transaction, the control system may provide a second discount for all or a portion of the transaction, and proceed to determine transaction totals.

The cited portion of Kaehler discloses two distinct payment scenarios: 1) where a transponder is used; and 2) where a transponder is **not** used. Kaehler teaches that only in the second scenario, when a transponder is **not** used, does the system look to whether a debit, credit or smartcard is used with the transaction. In Kaehler, when a transponder is used, the system **does not** receive any information related to a debit, credit, or smartcard. Kaehler does not disclose receiving **both** transmitter identification **and** payment information, wherein said payment information corresponds to a credit card, debit card, or bank account, or a combination thereof.

Moreover, even if Kaehler discloses receiving both transmitter identification data and payment information data — and it does not — Applicant respectfully submits that Kaehler does not disclose or suggest “electronically associating said transmitter identification data with said payment information.” At most, Kaehler discloses a transponder that may be loaded with pre-paid value through cash or a credit card. *See* Kaehler, col. 19, lines 55-67. (“the customer may use the cash acceptor or card reader at the fuel dispenser to add value to the transponder.”). At no point does Kahler discloses “electronically associating transmitter identification data with payment information, wherein the payment information corresponds to a credit card, debit card, or bank account, or a combination thereof.”

As stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The system of Kaehler teaches away from the capability of making any

type of association at all, because Kaehler specifically discloses that only a transponder or payment information are received. In fact, because Kaehler explicitly discloses using either a transponder or a credit or debit card, it specifically *teaches away from* receiving both transmitter identification and payment information, wherein said payment information corresponds to a credit card, debit card, or bank account, or a combination thereof and associating the transmitter identification data with the payment information.

Further, Claim 21 also recites, in part, “electronically enrolling a user associated with the customer transponder in a transaction processing program by storing enrollment data comprising said associated transmitter identification data and said payment information in said host transaction processing system.” The Office Action concedes that this limitation is not disclosed by Kaehler, but asserts that it is disclosed by Dahm. *See* Office Action, pages 2 and 3. Applicant respectfully disagrees. At most, Dahm discloses a system and method for providing customers with various offers on a mobile device. *See* Dahm, col. 2, lines 42-60. While the customer in Dahm may be able to enroll in a new mobile plan, Dahm does not disclose, or even suggest, enrolling a user associated with the customer transponder in a transaction processing program, as claimed.

Under 35 U.S.C. § 103(a), all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: “[T]he prior art reference (or references when combined) must teach or suggest all the claim limitation.” Because the cited references fail to disclose “electronically associating said transmitter identification data with said payment information,” “wherein the payment information corresponds to a credit card, debit card, or bank account, or a combination thereof,” or “electronically enrolling a user associated with the customer transponder in a transaction processing program by storing enrollment data comprising said associated transmitter identification data and said payment information in said host transaction processing system,” the rejection of independent claim 21 and all claims dependent thereon, is improper and must be withdrawn. Independent claims 24, 58, 62, 66 and 69 are allowable for similar reasons as discussed above regarding claim 21. Accordingly, these claims, and all claims dependent thereon, are allowable over Kaehler and Dahm.

**CONCLUSION**

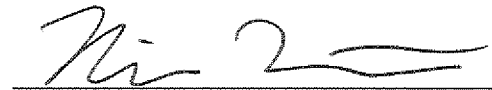
In view of the foregoing arguments and amendments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview—whether personal or telephonic—the Examiner is respectfully invited to telephone the undersigned with any suggestions leading to favorable disposition of the application.

Prompt and favorable consideration of this Amendment is respectfully requested. It is believed that all necessary fees are being charged for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicant also authorizes the Director to charge all required fees, fees under 37 C.F.R. § 1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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